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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/722,186

11/26/2003

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EXAMINER

LEE, JINHEE J

ART UNIT

PAPER NUMBER

2175

MAIL DATE

DELIVERY MODE

06/30/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/722,186	<b>Applicant(s)</b> KAMASAKI ET AL.	
	<b>Examiner</b> Jinhee J. Lee	<b>Art Unit</b> 2175	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) ☒ Responsive to communication(s) filed on 14 March 2008.

2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) ☒ Claim(s) 1-9, 13-16 and 19 is/are pending in the application.

    4a) Of the above claim(s)      is/are withdrawn from consideration.

5) ☒ Claim(s) 1-9 and 13-16 is/are allowed.

6) ☒ Claim(s) 19 is/are rejected.

7) ☐ Claim(s)      is/are objected to.

8) ☐ Claim(s)      are subject to restriction and/or election requirement.

**Application Papers**

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on      is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☒ All    b) ☐ Some \*    c) ☐ None of:

1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No.     .
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☐ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
    Paper No(s)/Mail Date     .

4) ☐ Interview Summary (PTO-413)  
    Paper No(s)/Mail Date     .

5) ☐ Notice of Informal Patent Application

6) ☐ Other:     .

## **DETAILED ACTION**

### ***Election/Restrictions***

#### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 19 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 19 recites the limitation "second display screen ....comprising: the first and second sort keys...the first set of keys..." in lines 7-9. This is confusing. "The first and second sort keys, and the first set of keys" are on the first display screen, if these are the same keys, then is the first display screen and the second display screen, one same screen? Clarify.

#### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Jackson (5894311).

Re claim 19 (as best understood), Jackson substantially discloses a display comprising:

A first display screen (figure 10 for example), comprising:

A first sort key (84 on figure 10 for example) having a first color and second sort key (76 for example) having a second color (see column 11 lines 48-50 according to the numbering in the middle for example);

A first set of keys (80 for example) corresponding to the first sort key and having the first color; and

A different set of keys (56 for example) from the first set of keys corresponding to the second sort key and having the second color; and

A second display screen (figure 11 for example) displayed when the first sort key is selected and comprising:

The first and second sort keys having the first and second colors, respectively.

Jackson does not explicitly disclose in the second display screen, the first set of keys corresponding to the first sort key and having a color different from the first color; a second set of keys corresponding to the first sort key and having the first color.

It would have been an obvious matter of design choice to have in the second display screen, the first set of keys corresponding to the first sort key and having a different color; a third set of keys corresponding to the first sort key and having the first color, since applicant has not disclosed that having differing color solves any stated problem or is for any particular purpose and it appears that the invention performs equally well with respectively corresponding colors as is disclosed in Jackson.

Furthermore, such a modification would have involved the mere application of a known technique to a piece of prior art ready for improvement. Where a claimed improvement on a device or apparatus is no more than "the simple substitution of one known element for another or the mere application of a known technique to a piece of prior art ready for improvement," the claim is unpatentable under 35 U.S.C. 103(a). Ex Parte Smith, 83 USPQ.2d 1509, 1518-19 (BPAI, 2007) (citing KSR v. Teleflex, 127 S.Ct. 1727, 1740, 82 USPQ2d 1385, 1396 (2007)). Accordingly Applicant claims a combination that only unites old elements with no change in the respective functions of those old elements, and the combination of those elements yields predictable results; absent evidence that the modifications necessary to effect the combination of elements is uniquely challenging or difficult for one of ordinary skill in the art, the claim is unpatentable as obvious under 35 U.S.C. 103(a). Ex Parte Smith, 83 USPQ.2d at 1518-19 (BPAI,

2007) (citing KSR, 127 S.Ct. at 1740, 82 USPQ2d at1396. Accordingly, since the applicant[s] have submitted no persuasive evidence that the combination of the above elements is uniquely challenging or difficult for one of ordinary skill in the art, the claim is unpatentable as obvious under 35 U.S.C. 103(a) because it is no more than the predictable use of prior art elements according to their established functions resulting in the simple substitution of one known element for another or the mere application of a known technique to a piece of prior art ready for improvement.

***Allowable Subject Matter***

7. Claims 1-9, 13-16 are allowed.

The following is a statement of reasons for the indication of allowable subject matter as previously stated:

Re claims 1, 4-6, 8-9. prior arts do not teach or suggest the combination of a touch-panel keyboard with the display part displaying first and second screens, displaying a plurality of sort keys and one first key or a plurality of first keys, switching the first screen to the second screen in response to an operation of one sort key of the plurality of sort keys, with changing the color of said one first key or said plurality of first keys on the first screen to colors different from the color of said one first key or said plurality of first keys, on the second screen and displaying said one second key or said plurality of second keys displayed correspondingly to the operated sort key with the same color as the color of the operated sort key on the second screen.

Re claims 2, 3, 7, prior arts do not teach or suggest the combination of a touch-panel keyboard with the display part displaying first and second screens, displaying a

plurality of sort keys and one first key or a plurality of first keys, the display control part setting the first and second screens on the display part, displaying the plurality of sort keys having different colors and said one first key or said plurality of first keys which are the same color as the color of the sort keys correspondingly to the plurality of sort keys, switching the first screen to the second screen in response to an operation of one sort key of the plurality of sort keys, and displaying said one second key or said plurality of second keys displayed correspondingly to an operated sort key with the same color as the color of the operated sort key on the second screen.

Re claims 13, 14, prior arts do not teach or suggest the combination of a display method of a touch-panel keyboard displaying the first screen, displaying a plurality of sort keys having different colors and one first key or said plurality of first keys which are the same color as the color of the sort keys, switching the first screen to the second screen in response to an operation of one sort key of the plurality of sort keys, and displaying one second key or a plurality of second keys displayed correspondingly to an operated sort key with the same color as the color of the operated sort key on the second screen.

Re claims 15, 16 prior arts do not teach or suggest the combination of a display program of a touch-panel keyboard displaying the first screen, displaying a plurality of sort keys having different colors and one first key or said plurality of first keys which are the same color as the color of the sort keys, switching the first screen to the second screen in response to an operation of one sort key of the plurality of sort keys, and displaying one second key or a plurality of second keys displayed correspondingly to an

operated sort key with the same color as the color of the operated sort key on the second screen.

### ***Response to Arguments***

8. Applicant's arguments filed 3/14/08 have been fully considered but they are not persuasive.

In response to applicant's arguments that the prior art does not teach the second screen with the first and second sort keys as claimed, examiner points out that it is obvious to have a second screen with the same color keys as the first screen.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jinhee J. Lee whose telephone number is 571-272-1977. The examiner can normally be reached on M-F at 8:30AM-5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Bashore can be reached on 571-272-2100 ext. 75. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jinhee J Lee/  
Primary Examiner, Art Unit 2175

jji